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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/721,793	11/26/2003	Miguel Corona Villegas	2099.0070001/JAG/LBB	6600

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STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

DESAI, ANAND U

ART UNIT	PAPER NUMBER
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1656

MAIL DATE	DELIVERY MODE
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02/21/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action
Before the Filing of an Appeal Brief

Application No.

10/721,793

Applicant(s)

CORONA VILLEGAS ET AL.

Examiner

Anand U. Desai, Ph.D.

Art Unit

1656

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 24 January 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 24 January 2007. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☒ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).


4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: 3.
Claim(s) objected to: _____.
Claim(s) rejected: 47-50.
Claim(s) withdrawn from consideration: 51-70.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.



ROBERT A. WAX
PRIMARY EXAMINER

Continuation of 3. NOTE: The claims as amended do not overcome the 35 U.S.C. 112, first paragraph, written description rejections. The remarks cite the Official Gazette that set forth the guidelines for the treatment of product and process claims in light of the Federal Circuit's decisions *In re Ochiai* and *In re Brouwer*. The product claims 47-50 are not found allowable and therefore the process claims are not rejoined. Applicants' state claims 47-50 do not claim new matter and cite Table 1 from page 7 of the specification, which identifies 71 clones from the genus of scorpions, *Centruroides*. Applicants' state claims 47-50 have proper written descriptive support in the specification as filed. Applicants' cite the "Revised Interim Written Description Guidelines Training Materials" and state the facts set forth in Example 14 are almost identical to the present situation, and support a finding of proper written descriptive support for claims 47-50. Applicants' arguments are not persuasive. Example 14 in the Training Materials is drawn to a protein with a known function, whereas the current pending claims are drawn to a polynucleotide. It appears Example 11 is more representative of the present situation. For example, the specification does not disclose a genus of isolated polynucleotides comprising a nucleic acid sequence at least 83% identical to the sequence of SEQ ID NO: 115. Where are the modifications to the polynucleotide disclosed such that one of ordinary skill in the art would know that polynucleotide encodes a functional toxin that binds to what sodium channel? There is insufficient structure to function correlation for the genus of polynucleotides encompassed by claims 47-50. Identification of one species of a scorpion toxin that has 82.8% identity to SEQ ID NO: 115 (SEQ ID NO: 111) does not describe a genus of polynucleotides, which are at least 83% identical to SEQ ID NO: 115 that encode toxins that bind sodium channels.